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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,885	09/19/2000	Richard Rubin	4138-A1	5127
29370	7590	02/02/2005	EXAMINER	
ROBERT A. PARSONS 340 E. PALM LN SUITE 260 PHOENIX, AZ 85004			PASCUA, JES F	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/664,885

Applicant(s)

RUBIN, RICHARD

Examiner

Jes F. Pascua

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,428,103 to Walsh.

Walsh discloses a container for keeping food warm comprising a pouch 10 formed of a plastic material 30, 36 to provide water impermeability, the pouch being constructed to define an insulated and substantially water impermeable food chamber. The chamber of the pouch is insulated with insulating material 34, which is superimposed with the plastic material 30, 36 and reflecting layer 32 to form an insulating structure. The pouch of Walsh further comprises opposing substantially coextensive lips 24 defining a passage for inserting food into the chamber of the pouch. Lips 24 include a closure 42 of complementary engagement elements.

Walsh discloses the claimed invention, especially the pouch including layers of water impermeable, plastic material 30, 36. However, it is unclear if the layers of plastic material are film and/or cloth. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use layers of film and/or cloth for the water impermeable, plastic material of Walsh, since it has been held to be within the general

skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 7, 13 and 20, Walsh discloses the claimed invention, as discussed above, except for the complementary engagement elements comprising hooks and loops instead of a zipper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the zipper of Walsh with complementary hook and loop engagement elements since the Examiner takes Official Notice of the equivalence of hook and loop engagement elements and zippers for their use in the pouch art and the selection of any of these known equivalents to actively couple the lips 24 would be within the level of ordinary skill in the art.

Regarding the recitation "the lips formed to provide a passive, non-sealing engagement between the lips", Walsh discloses the walls 16, 20 of the pouch being insulated by insulating material 34. Walsh further discloses that the insulating material 34 as being "soft, flexible and resilient". See column 2, lines 36-40. The resilient nature of the insulating material 34 would cause the wall 12 to spring back into the position shown in Figs. 1, 2, 4 and 5 after being bent as shown in Fig. 3. Since lips 24 are connected to the walls 16, 20, the resilient nature of the insulating material 34 in the walls 16, 20 inherently cause the lips 24 to provide a "passive, non-sealing engagement between the lips" as claimed. Furthermore, until closure 42 is activated by a user to couple together lips 24, a "partial enclosure" of the chamber is provided.

Having demonstrated that the pouch of Walsh inherently forms a "partial enclosure caused by the passive, non-sealing engagement between the lips and the

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food warming chamber”, the function recitation “to inhibit a build-up of moisture vapor produced from warm food disposed in the warming chamber for preventing warm food disposed in the warming chamber from becoming soggy and to allow enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist” is met by Walsh. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Response to Arguments

3. Applicant's arguments filed 11/24/2004 have been fully considered but they are not persuasive.

Applicant's remarks that the reopening of prosecution after the Board decision is improper have been considered. It is brought to applicant's attention that the Examiner's Director, E. Rollins-Cross, authorized the Office action of 08/25/2004 for the consideration of matters not already adjudicated. See 37 CFR 1.198. In this case, the matter that was not already adjudicated is the rejection of claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,428,103 to Walsh.

Regarding applicant's remark that the water impermeability of the Walsh container "is not discussed by Walsh, and therefore, not taught by Walsh." Applicant's attention is directed to column 2, lines 30-33 of Walsh, which states, "Preferably, outer layer **30** and inner layer **36** should be flexible, waterproof, washable and durable. A suitable plastic material may be used." The "waterproof" characteristic of the layers 30, 36, disclosed by Walsh, meet applicant's recitation "a pouch including a layer formed of a film of plastic to provide water impermeability".

Regarding applicant's remark that "no lips are shown or described by Walsh", the front side 24 as shown in Figs. 1-5 of Walsh meets the recitation "lips" to the same degree applicant structurally sets forth in the claims.

In response to applicant's argument that "Nothing in Walsh even remotely suggest 'lips formed to provide a passive, non-sealing engagement between the lips'." a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, functional recitation "to provide a passive, non-sealing engagement between the lips" fails to result in any *structural difference* between the "lips" of the claimed invention and the front side 24 of Walsh.

Conclusion


4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 571-272-4546. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 571-272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jes F. Pascua
Primary Examiner
Art Unit 3727

JFP